UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,067	07/07/2000	Joel Naumann	CISCO-2390	6900

7590 04/01/2005		EXAMINER	
Timothy A. Brisson		KADING, JOSHUA A	
Sierra Patent Group, Ltd.			
P. O. Box 6149		ART UNIT	PAPER NUMBER
Stateline, NV 89449		2661	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/612,067	Applicant(s) NAUMANN, JOEL
	Examiner Joshua Kading	Art Unit 2661

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>14 March 2005</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

     Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

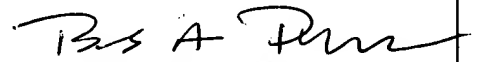   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

BOB PHUONG LH
PRIMARY EXAMINER

 Continuation of 11. does NOT place the application in condition for allowance because: applicant's arguments are not persuasive. Beginning on page 8 of applicant's REMARKS filed 3-14-05, applicant argues that "Bontemps does not teach communication between a PCI-compliant front card configured to accept a LAN or WAN compliant back card...," that Bontemps' "LINK_DETECT signal is not the equivalent of an IDSEL signal, that Bontemps lacks, "if said sensing signal is a logical low, then coupling [an] IDSEL signal corresponding to a...channel...," that one of ordinary skill in the art would not reasonable expect to "draw that Bontemps can be extended to [a] PCI-compliant front card having a MAC located thereon...," and there is insufficient motivation to combine AAPA with Bontemps. The examiner respectfully disagrees.

Firstly, applicant is mistaken that Bontemps is not directed towards being configurable with a LAN or WAN type back card. As read in col. 1, lines 27-32 of Bontemps, there is full disclosure for the use of Bontemps' invention in a LAN or WAN environment, which would automatically include any card used in such an environment.

Secondly, applicant is misreading the rejection of the IDSEL signal. The "LINK_DETECT signal" of Bontemps is not used as the equivalent of the IDSEL signal. Instead, the "LINK_DETECT signal" is used as the sensing signal of applicant's invention. The "XOVER_SEL" signal of Bontemps is the signal that is used as the functional equivalent of applicant's IDSEL signal. The reason for that is because both the "XOVER_SEL" signal and applicant's IDSEL signal are used to select a card/channel given a specific sensing signal. Therefore, although Bontemps does not call the "XOVER_SEL" signal an IDSEL signal, they perform the same function.

Thirdly, applicant is correct in asserting that Bontemps does not explicitly disclose the "sesing signal [being] a logical low" and "then coupling [an] IDSEL signal." However, as explained in the body of the rejection, it would have been obvious to one of ordinary skill in the art to know that the use of "high" or "low" signals in an invention is purely a matter of design choice and the overall function/purpose of the invention remains the same. Using a "low" signal instead of a "high" signal holds no advantage over using a "high" signal instead of a "low" signal because they both are used as indicators of a condition and as long as the system can differentiate between the two (and know what each means), they are both obvious expedients with respect to one another.

Fourthly, applicant demands evidence be shown that Bontemps can be used with a PCI-compliant device having a MAC located thereon. First, as seen in figures 2 and 3 of Bontemps there are clear indications of a MAC device within the context of Bontemps' invention. AAPA is further used to show (as seen in figure 2 of AAPA) that the two inventions are indeed directed toward the same art (e.g. see elemen 112 of AAPA and element 324 of figure 3 in Bontemps). Further, applicant demands proof of the use of a PCI-compliant device with Bontemps. Again, AAPA covers this as seen in figure 3, but for additional support applicant is directed to the fact that Bontemps can be directed to a general Fast Ethernet type system (col. 2, lines 1-10). And this type of Fast Ethernet type system is fully PCI-compliant as seen in U.S. Patent 5,781,549, Dai at figure 2, element 248 and col. 5, lines 33-36.

Lastly, the motivation to combine the "tri-state buffer" and "IDSEL coupling" of Bontemps with the rest of the invention as described in AAPA can be read in col. 3, lines 33-34 and 66-col. 4, lines 1-4 of Bontemps. Applciant is reminded that the motivation does not need to be the same as applicant's (i.e. the motivation does not need to be directed towards solving applicant's problem). See MPEP § 2144.